

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. ERLAND

Appeal No. 1998-2864
Application No. 08/338,235

ON BRIEF

Before KRASS, JERRY SMITH and BARRETT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the rejection of claims 1, 2, 4, 6-8, 14-17 and 19.

The invention pertains to a control console remote monitoring system. In particular, a portable monitoring unit is used for remotely monitoring measurement data provided at a

control console. Thus, if the person responsible for monitoring the control console is away from the console, that person can still monitor the control console by observing the data on the portable, remote unit.

Representative independent claim 1 is reproduced as follows:

1. A portable monitoring unit for remotely monitoring measurement data provided at a control console that includes processing means for processing measurement data related to a plurality of monitored parameters and for responding to a request for transmission of measurement data pertaining to a parameter selected from said plurality of monitored parameters by causing a radio coupled to the control-console processing means to transmit said selected-parameter measurement data, the portable unit comprising

a display device;

a keypad for selecting said parameter as to which measurement data is to be displayed by the display device and for enabling said measurement data that is to be displayed to be requested from the control-console processing means;

a radio for transmitting a said request to the radio that is coupled to the control console and for receiving said measurement data transmitted by the radio that is coupled to the control console; and

a processor coupled to the keypad, the portable-unit radio and the display device, and adapted for responding to an operation of the keypad to select a parameter as to which measurement data requested from the control-console processing means is to be displayed by causing the portable-unit radio to transmit to the radio coupled to the control console a request for transmission of said measurement data selected by operation of the keypad and for causing the display device to display said measurement data that is received by the portable-unit radio.

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The examiner relies on the following references:

Freedman	3,082,413	Mar. 19, 1963
Kobayashi et al.	5,003,479	Mar. 26, 1991
Freeman	5,084,695	Jan. 28, 1992
Crane	5,257,190	Oct. 26, 1993

Claims 1-20 are pending, with many claims being rejected under 35 U.S.C. 103. As evidence of obviousness, the examiner cites Kobayashi with regard to claims 1, 2, 4, 7, 8, 14 and 19, adding Crane with regard to claims 6 and 15. In a new ground of rejection entered in the supplemental answer, the examiner also rejects claims 8 (again) and 17 under 35 U.S.C. 103 over Kobayashi.

In a new ground of rejection entered in the principal answer, the examiner rejects claims 16 and 17 under 35 U.S.C. 103 over Kobayashi.

At page 9 of the principal answer, the examiner indicates that claims 3, 5, 9-13, 18 and 20 would be allowable if rewritten to overcome a rejection under 35 U.S.C. 112. Thus, the examiner is indicating that claims 3, 5, 9-13, 18 and 20 are directed to allowable subject matter.

We find it confusing that, in the principal answer, the

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examiner refers to Paper No. 6 for the rejection of claims 1, 2, 4, 6-8, 14, 15 and 19 under 35 U.S.C. 103 but does not refer to this Paper for the rejection under 35 U.S.C. 112. The examiner also does not repeat the rejection under 35 U.S.C. 112 in either of the answers. Moreover, the problem regarding the rejection under 35 U.S.C. 112 involved the elimination of "a" in "a parameter" rather than in "a keypad." In light of this, and in light of the fact that the appendix to the principal brief shows the correction to the claims which would have overcome any such rejection under 35 U.S.C. 112 and the examiner, in the principal answer, indicates that this is a correct copy of the claims on appeal, we will understand the rejection under 35 U.S.C. 112 to have been withdrawn and that claims 3, 5, 9-13, 18 and 20, being directed to allowable subject matter, are no longer on appeal before us.

Accordingly, we limit our opinion herein to the rejection of claims 1, 2, 4, 7, 8, 14, 16, 17 and 19 under 35 U.S.C. 103 over Kobayashi and to the rejection of claims 6 and 15 under 35 U.S.C. 103 over Kobayashi in view of Crane (Paper No. 6, pages 5-6)

We are somewhat confused as to the listing by the examiner, in the principal answer, page 4, of the Lemelson, Breit, Bomar, Tin, Freedman and Freeman patent references since none of these

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references appear in any statement of rejection against the instant claims. Accordingly, we have not considered these references in our decision infra.

Reference is made to the briefs and answers for the respective positions of appellant and the examiner.

OPINION

Turning, first, to the rejection of claims 1, 2, 4, 7, 8, 14, 17 and 19 under 35 U.S.C. 103 over Kobayashi, it is the examiner's position, with regard to independent claim 1, that Kobayashi discloses the claimed display device at 31, the claimed keypad at 32 and the claimed processor at 28. The examiner recognizes that Kobayashi does not teach or suggest the claimed radio but contends that the inclusion of the claimed radio would have been obvious, within the meaning of 35 U.S.C. 103, "since wireless system [sic] is well-known and widely preferred nowadays for its advantages of convenience and wiring reduction" [principal answer-page 5].

Appellant does not argue any error in the examiner's correspondence of elements between Kobayashi and the instant

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claimed subject matter. Moreover, appellant does not dispute that wireless systems "are widely used and preferred for some applications for advantages of convenience and wiring reduction" [principal brief-page 8]. Rather, appellant argues that it would not have been obvious to apply wireless technology to Kobayashi because Kobayashi is "not one of those applications in which the use of a wireless system would provide such advantages" [principal brief-page 8]. In particular, appellant urges that because Kobayashi's portable device 25 is used in the immediate vicinity of the vehicle 1, a wireless system is not more convenient and, in fact, because of the added cost and possibility of interference, a non-wireless communication link is preferred in Kobayashi.

Appellant further distinguishes the instant claimed subject matter by reason of the processor 26 of the portable monitoring unit 24 being coupled to the keypad 32 for responding to an operation of the keypad 32 to select a parameter as to which measurement data is to be displayed. Appellant points out that in Kobayashi's portable diagnosis device 25, processor 28 is coupled to the keypad 32 for responding to an operation of the keypad 32 to select a diagnosis mode as to which measurement data is to be displayed. "This distinguishing feature enables display

of data for a specific monitored parameter in contrast to mere display of data related to a given diagnostic mode" [principal brief-page 9].

We do not find appellant's arguments persuasive.

While Kobayashi does not employ radio communication because of the proximity of the portable device to the vehicle, and so non-wireless communication is the preferred embodiment in that environment, appellant does not deny the obviousness of employing wireless communication in certain applications. In those situations where portable diagnosis devices are not so proximate to the unit under diagnosis, it would appear then that even appellant would agree that artisans would have found it obvious to use wireless communications. Accordingly, even though Kobayashi uses non-wireless communication, the skilled artisan would have understood that for more distant applications, a wireless communication system, such as radio communication, would have been employed. Even in Kobayashi, while wireless communication might be more costly and possibly cause some interference problems, triggering the decision of a designer to employ non-wireless communication, the artisan still would have understood that wireless communication is an option, the choice

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of its use being subject to the well known design considerations of wireless vs. non-wireless communication.

Thus, we conclude, as did the examiner, that the artisan would have found it an obvious modification of Kobayashi to extend its teachings to a wireless environment where the portable device 25 may be in wireless communication with vehicle 1.

With regard to appellant's argument that the monitoring nature of the instant invention distinguishes over the diagnosis nature of Kobayashi, we, again, disagree. Clearly, monitoring is part of diagnosing since a diagnosis cannot be made unless a situation is monitored.

Thus, we will sustain the rejection of claim 1 under 35 U.S.C. 103 over Kobayashi. We will also sustain the rejection of independent claim 7 under 35 U.S.C. 103 since this claim falls with claim 1 [principal brief-page 6] and is not argued separately.

Turning to claim 2, with which claims 4, 8 and 19 stand or fall together, this claim recites an alarm provided by other than the display device and the provision of both an alarm and a display of an alarm condition in response to an alarm-condition signal sent from the control-console processing means.

The examiner admits that Kobayashi does not disclose means other than the display device for providing an alarm but contends that the artisan would have "recognized using another alarm device to provide an alarm to the operator, for instance, a buzzer to indicate the alarm, because it is easier to recognize an alarm situation when it is audibly notified. It is noted that the system of Kobayashi includes alarm indicators 23a on the control system 2 and LEDs 30 on the remote unit 25, although no function is described" [principal answer-page 5].

It is appellant's position that because Kobayashi displays an alarm value only when the user selects for display a particular diagnosis mode in which the alarm value is displayed in response to such selection, Kobayashi does not suggest the use of another alarm device whereby a user becomes aware of an alarm condition transmitted from a control console without having to either constantly monitor the display or request measurement data for a given parameter in which an alarm condition might exist.

The examiner's response is that the use of means other than the display device for providing an alarm is "old in the art."

We agree with the examiner that the use of means other than the display device for generating an alarm is "old in the art." We recognize that where the examiner relies on what is asserted

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to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. In re Sang-Su Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

In the instant case, the examiner has articulated the knowledge alleged to be "old in the art" by the examiner. That is, we view Kobayashi as being very clear that the display may display what can be considered an "alarm" and we agree that artisans know that it was very common for devices to be supplied with more than one alarm in order to alert a user to a condition which must be attended to promptly. The buzzer, cited by the examiner, is such an example. For example, if one is baking a cake, one may stand in front of the oven and look through the door (as a "display") and being alert for an "alarm" condition whereby the cake may be burning or over-baked. But cooking artisans, in this example, know that one may also set a timer, which emits an audible alarm, or buzzer, at a preset time, to alert the artisan that to leave the cake in the oven any longer would invite the "alarm" condition whereby the cake will be burned. That timer is but one example of the use of a "means other than the display device for providing an alarm." We find that the use of an alternative alarm means in addition to a display for alerting an operator to a condition is so well known to artisans, and even to laymen,

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that such an alternative alarm means in the instant invention would have been obvious within the meaning of 35 U.S.C. 103.

We note, in passing, that in the response section of the principal answer, at page 15, the examiner attempts to cite U.S. Patents to Freedman and Freeman as evidence of the use of other alarm means. While these references may, indeed, provide for such alarm means, Freedman and/or Freeman form no part of the statement of the rejection and we will not consider them. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). In any event, we do not consider these references necessary as, in our view, the rejection of claims 2, 4, 8 and 19 under 35 U.S.C. 103 is proper without them.

With regard to claim 14, this claim adds the limitation to claim 7 of providing, by the control console, a display of measurement data, whereas, as argued by appellant, Kobayashi displays measurement data only by display 31 in the portable diagnosis device 25. It is appellant's position that the lamps 23a, 23b merely indicate an abnormality in the electronic control system 2 and do not display measurement data. This distinguishing feature is said to enable a person at the control console to observe the requested measurement data.

It is the examiner's position, with regard to claim 14, that the claimed memory is met by Kobayashi's element 4 and that the claimed display is met by elements 23a and 23b, wherein the processing unit 3 is adapted for causing the measurement data to be transmitted in response to a request sent from 25 to be stored in 4 and for causing the stored data to be retrieved for display by lamps 23a and 23b. The examiner further explains, at pages 16-17 of the principal answer, that since the language of claim 14 does not specify exactly when the data is retrieved and how it is retrieved, the control console display is broadly interpreted as lamps 23a and 23b which indicates, respectively, trouble code and trouble detected as a result of the self-diagnosis [column 3, lines 16-26, of Kobayashi]. The examiner also points out that since the claim fails to specify how measurement data is displayed, it is broadly interpreted as being displayed in a "yes" or "no" indication by lamps 23b and in a form of trouble code indicated by lamps 23a whenever the measurement data reaches the alarm threshold.

We will not sustain the rejection of claim 14 under 35 U.S.C. 103 because we view the examiner's interpretation as being overly broad. Claim 14 requires that the stored data to be retrieved and displayed be "selected-parameter measurement data."

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The lamps 23a and 23b of Kobayashi, albeit, arguably, "displays" of an alarm condition, do not, in any way, act to display

selected-parameter measurement data which has been retrieved from memory in the control console.

With regard to claims 6 and 15, the examiner relies on Crane for the teaching of a radio system that has memory to store information received from another processor at another location. The examiner then contends that the artisan would have recognized the desirability of storing pluralities of information in Kobayashi's memory so that the information can be retrieved locally. With regard to the limitation of a memory to store measurement data in which the measurement data of a selected parameter is selected by the operation of a keypad, the examiner asserts that this claim limitation "lacks criticality" [principal answer-page 8].

Even if we assumed that the examiner's application of Kobayashi and Crane is reasonable, we will not sustain the rejection of claims 6 and 15 under 35 U.S.C. 103 because the examiner may not dismiss an explicit claim limitation by stating that it "lacks criticality." As explained by appellant [page 12 of the principal brief], this feature enables an operator of the

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portable monitoring unit to select any previously received measurement data for display. Accordingly, the disputed limitation, quite clearly, is "critical." In any event, lack of "criticality" is not a measure of the obviousness of the claimed subject matter. The examiner was apparently using a "design choice" rationale in rejecting claims 6 and 15 but we cannot agree that the storage of information regarding measurement data for later retrieval so that an operator may select, via a keypad, measurement data of a selected parameter is a mere "design choice."

Since the examiner has not sufficiently addressed this claim limitation in the rejection, we will not sustain the rejection of claims 6 and 15 under 35 U.S.C. 103.

Claim 16 recites that the control console is in "the engine room, the control room or the bridge of a ship and the monitored parameters pertain to operation of the ship." It is the examiner's position that while Kobayashi does not disclose such an environment of use, teaching, instead, that the control is located in an engine of an automobile, the artisan would have readily recognized using Kobayashi's system in a ship environment, if desired. That is, the examiner contends that the claim limitations of claim 16 merely indicate an intended use.

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Appellant responds by alleging that one skilled in the art of monitoring parameters of a ship, upon considering how to remotely monitor such parameters from various locations within the ship, would not have considered Kobayashi's motor vehicle system because the portable diagnosis device 25 of Kobayashi's diagnostic system is coupled to a motor vehicle engine electronic control system 2 by a harness 27 and thereby used only within the immediate vicinity of the motor vehicle engine.

We will sustain the rejection of claim 16 under 35 U.S.C. 103 as it appears reasonable to us that the artisan, having the automotive monitoring/diagnostic system of Kobayashi before him/her, would clearly have been led to employ such a system in other environments, especially to other vehicle environments, such as a ship. The claim specifies no language which would make the claimed invention especially adapted to ship monitoring systems but unworkable for other vehicle environments because of something unique to ships. Accordingly, we agree with the examiner's rationale that this claim limitation is directed solely to intended use.

We also will sustain the rejection of claim 17 under 35 U.S.C. 103 because we view the claim broadly as requiring only a means for producing an alarm (the display of Kobayashi will

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display alarm conditions to an operator) and coupling the portable unit to the alarm providing means for responding to receipt of an alarm-condition signal in order to display the alarm condition (again, in Kobayashi, the display of the portable unit 25 will indicate an alarm condition since an abnormality of the vehicle system will be displayed to the operator and any abnormality is an alarm condition).

CONCLUSION

We have sustained the rejection of claims 1, 2, 4, 7, 8, 16, 17 and 19 under 35 U.S.C. 103 but we have not sustained the rejection of claims 6, 14 and 15 under 35 U.S.C. 103.

Accordingly, the examiner's decision is affirmed-in-part.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

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